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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,808	09/08/2003	Geoffrey B. Rhoads	P0880	1809
23735	7590	12/19/2007		
DIGIMARC CORPORATION 9405 SW GEMINI DRIVE BEAVERTON, OR 97008			EXAMINER CHEN, SHIN HON	
			ART UNIT 2131	PAPER NUMBER
			MAIL DATE 12/19/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/658,808	<b>Applicant(s)</b> RHOADS, GEOFFREY B.	
	<b>Examiner</b> Shin-Hon Chen	<b>Art Unit</b> 2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 October 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-52 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/5/07</u> . | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Claims 1-52 have been examined.

#### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-22 and 24-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tone et al. U.S. Pat. No. 6640306 (hereinafter Tone) in view of Stefik et al. U.S. Pat. No. 6233684 (hereinafter Stefik).
4. As per claim 1, Tone discloses a method for utilizing a title signal contained in digital data through a comparison of the title signal to a player signal stored in a player device, the method comprising the steps of: downloading the digital data having the title signal via an Internet connection (Tone: column 4 lines 27-32); transferring the downloaded digital data to the player device (Tone: column 6 lines 7-13); detecting, at the player device, the title signal in the data: comparing the title signal to the player signal (Tone: column 7 lines 7-14); and performing an action based upon the comparison (Tone: column 7 lines 12-14). Tone does not explicitly disclose wherein the title signal is carried with digital watermarking encoded in the digital data. However, Stefik discloses embedding watermark in a digital work to provide information relating to the owner of a document (Stefik: column 3 lines 25-30). It would have been obvious to one having ordinary skill in the art to include the watermark into the digital data that contains

title signal/ownership ID to identify the owner of the digital works because they are analogous art. Therefore, it would have been obvious to one having ordinary skill in the art to combine the teachings of Stefik within the system of Tone because the information will help prevent unauthorized copying or access of the digital works (Stefik: column 3 lines 35-38).

5. As per claim 2, Tone discloses the method of claim 1. Tone discloses that the data can be transmitted through any communication link and the data comprises any data not limited to streaming video or audio data (Tone: column 6 lines 29-36).

6. As per claim 3, Tone discloses the method of claim 1. Tone further discloses wherein the player signal is indicative of an attribute of the device, device user, data, or data owner (Tone: column 7 line 7-9: owner ID of the device).

7. As per claim 4, Tone discloses the method of claim 1. Tone further discloses the method comprises the steps of: decoding the digital watermarking to obtain the title signal (Stefik: column 13 lines 48-62).

8. As per claim 5, Tone discloses the method of claim 4. Tone does not explicitly disclose wherein the watermark signal contains a copy protection subsignal of a predetermined number of bits, the title signal being a portion of the predetermined number of bits unused by the copy protection subsignal. However, Stefik discloses that embedding watermark into a data to control the distribution or use of data and the watermark provides information about the owner of the

data (Stefik: column1 lines 47-54; column 3 lines 31-34). It would have been obvious to one having ordinary skill in the art to embed owner ID of the device into the data as watermark because they serve as digital rights to access data. Therefore, it would have been obvious to one having ordinary skill in the art at the time of applicant's invention to combine the teachings of Stefik within the system of Tone because it controls the distribution and use of digital works.

9. As per claim 6, Tone discloses the method of claim 1. Tone further discloses wherein the action is performed if the title signal matches the player signal (Tone: column 7 lines 7-14).

10. As per claim 7, Tone discloses the method of claim 1. Tone further discloses wherein the action is to inform the device user of the match and at least one consequence thereof (Tone: column 9 lines 12-17).

11. As per claim 8, Tone discloses the method of claim 7. Tone discloses once the identification data match, the actions can be performed including using data and not limited to notifying the user of business activities (Tone: column 7 lines 12-14).

12. As per claim 9, Tone discloses the method of claim 7. Tone further discloses wherein the digital data is digital video data (Tone: column 6 lines 33-36).

13. As per claim 10, Tone discloses the method of claim 7. Tone further discloses wherein the digital data is digital audio data (Tone: column 4 lines 10-15).

14. As per claim 11, Tone discloses the method of claim 7. Tone further discloses wherein the action is to inform the device user of the match and of the player signal (Tone: column 7 lines 7-14).

15. As per claim 12, Tone discloses the method of claim 3. Tone further discloses wherein the player signal is indicative of a device number (Tone: column 7 lines 7-8).

16. As per claim 13, Tone discloses the method of claim 1. Tone further discloses the step of encoding the title signal in a time varying manner (Tone: column 7 lines 40-47).

17. As per claim 14, Tone discloses the method of claim 3. Tone further discloses the step of inputting the player signal to the player device prior to the comparing step (Tone: column 7 lines 60-62).

18. As per claim 15, Tone discloses the method of claim 6. Tone further discloses wherein perfect matching between the title signal and player signal is necessary in order to perform the action (Tone: column 7 lines 7-14).

19. As per claim 16, Tone discloses the method of claim 6. Tone further discloses wherein imperfect or approximate matching between the title signal and player signal is permitted in order to perform the action (Tone: column 7 lines 7-14).

20. As per claim 17, Tone discloses the method of claim 6. Tone further discloses wherein the title signal and player signal contain at least two fields, each field comprising a group of bits, wherein matching of fields between the title signal and player signal is permitted in order to perform the action (Tone: column 7 lines 7-14; column 7 lines 60-62).

21. As per claim 18, Tone discloses the method of claim 1. Tone further discloses wherein at least one title signal which when compared to the player signal evokes the performance of the action (Tone: column 7 lines 7-14).

22. As per claim 19, Tone discloses the method of claim 1. Tone further discloses wherein at least one title signal which when compared to the player signal evokes the performance of the action, is chosen to match at least one targeted demographic group (Tone: column 7 lines 7-14).

23. As per claim 20, Tone discloses the method of claim 1. Tone further discloses wherein the action is performed if the title signal matches the player signal and the action is to inform the device user of the match (Tone: column 9 lines 12-16).

24. As per claim 21, Tone discloses the method of claim 1. Tone further discloses wherein the player device is a personal computer and the transferring step comprises storing the downloaded data to a recordable medium readable by the player device (Tone: column 4 lines 4-10).

25. As per claim 22, Tone discloses the method of claim 21. Tone further discloses wherein the detecting, comparing and performing steps are performed after the storing step is completed (Tone: column 7 lines 7-14).

26. As per claim 24, Tone discloses the method of claim 1. Tone further discloses wherein the player device is a personal computer and at least the detecting step is performed in real time as the digital data is downloaded (Tone: figure 10 and column 10 line 57 – column 11 line 48).

27. As per claim 25-48, claims 25-48 encompass the same scope as claims 1-22 and 24. Therefore, claims 25-48 are rejected based on the same reason described in rejecting claims 1-22 and 24.

28. Claims 23, 49-52 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tone.

29. As per claim 23, Tone discloses the method of claim 21. Tone does not explicitly disclose wherein the detecting, comparing and performing steps are performed after the downloaded digital data is partially stored such that the title signal is available for use in the method before the storing step is completed. However, Tone discloses the purpose of protecting the digital data is to embed owner ID into the data. Therefore, the method of communicating the title signal varies depending on the communication method provided (i.e. streaming or on-demand).



30. As per claim 49, Tone discloses the method of claim 1. Tone does not explicitly disclose the title information is used as private key. However, one with ordinary skill in the art would understand that comparison/decryption method for authentication is well known and can be interchangeably used based on the designer's choice. Therefore, cryptographic authentication utilizing the same parameter would work equally well in the method disclosed by Tone.

31. As per claim 50-52, claims 50-52 encompass the same scope as claims 1-24. Therefore, claims 50-52 are rejected based on the same reason as claims 1-24.

#### *Response to Arguments*

32. Applicant's arguments filed on 10/16/07 have been fully considered but they are not persuasive.

Regarding applicant's remarks, applicant argues that the prior art of record does not disclose that the title signal is carried with digital watermarking encoded in the digital data as disclosed in amended claim 1. However, the examiner has relied on the Stefik reference to combine with Tone in disclosing embedding digital watermark into ownership identified digital works. Therefore, applicant's argument is traversed.

On the other hand, applicant argues that the Tone is not a valid reference because it is filed after some of the parent applications, namely U.S. Patent 5,862,260. However, specification of the parent case does not disclose title signal in the specification. Therefore, recitation of universal code and method disclosed in the prior application is insufficient to remove the prior art from record.

*Conclusion*

33. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shin-Hon Chen whose telephone number is (571) 272-3789. The examiner can normally be reached on Monday through Friday 8:30am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


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Shin-Hon Chen  
Examiner  
Art Unit 2131

SC

  
**AYAZ SHEIKH**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2100**